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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,548	03/19/2001	Aki Tomita	520.39598X00	6782

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,548

Applicant(s)

TOMITA ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to the amendment filed on June 01, 2004.
2. The Examiner acknowledges the cancellation of Claim 2 in the current amendment filed on June 01, 2004; in addition to the other canceled claims 4 and 6 in previous amendments.
3. Claims 1, 3, 5 and 7-18 are presented for examination following the amendment.
4. Claims 1, 3, 5 and 7-18, are rejected under 35 U.S.C. 103(a).

***Priority***

5. Applicant's claim for foreign priority under 35 U.S.C. §119(a)–(d) is acknowledged. Therefor accorded the benefit date of 01 November, 2000.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 5, 7-8, 10 and 14-18, are rejected under 35 U.S.C. 103(a) as being unpatentable by Itaru Nishizawa (U.S. Patent No. 6,519,598 and Nishizawa hereinafter) in view of Takashi Suzuki (U.S. Patent No. 6,125,304 and Suzuki hereinafter).

Regarding Claims 1, 3, 5, 8, 14-16 and 18 Nishizawa discloses:

host computer (Col 4, Line 22, i.e. *client computer 101 and 102*)

a skeleton program for instructing data format transformation (Col 8, Lines 21-22, i.e. *when the XML application<sup>1</sup> issues the data request 1412; see also Figure No. 6, Element No. 602, i.e. receive the data request from a client computer*)

a communication program (Figure No. 1, Element No. 106; see also Col 4, Lines 29-33, i.e. *The magnetic disk apparatus<sup>2</sup> 108 comprises a network interface for connecting the magnetic disk apparatus to the network and for assuring communication between the client computers and the data conversion program server*)

said disk storage device having (Figure No. 3, Element No. 320)

a data format transforming program<sup>3</sup> (Figure No. 3, Element No. 316)

a second communication program (Figure No. 3, Element No. 323)

said the skeleton program sending a request to said data format transformation program (Col 5, Lines 22-25, i.e. *the client issues the data request to the magnetic disk apparatus. An example of the data request is shown in FIG. 10. the data request includes three designations of data output format ) on said disk storage (please note that this was established earlier above, see Figure 3, Element 316) via said communication program for communicating with said disk*

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<sup>1</sup> Please note that the Examiner is interpreting this example of the "XML Application" to be the same as the "skeleton program" as they both are programs that are requesting a conversion or a transformation.

<sup>2</sup> Please note that the Examiner is interpreting this "*magnetic disk apparatus*" to be the same as the "disk storage" of Claim No. 1

<sup>3</sup> Please note that the Examiner is interpreting the "data format transforming program" to be the same as the "data conversion" in the Nishizawa reference.

storage, (*also was established earlier above, see figure 3, Element 323*) at the time of data format transformation (Figure No. 6, Element No. 607 and 608)<sup>4</sup>

said data format transformation program receiving the request via said second communication program (Figure No. 6, Element No. 602)

said data format transformation program performing the data format transformation (Figure No. 6, Element No. 607).

storing by said disk storage device, data having another data format (Figure 1, Element No's. 110, 111 and 107; see also Figure 2, Element No. 205-207 and 210; see also Col 10, Lines 6-9, i.e. or storing the converted data in the form previously requested from said client computer of the requester)<sup>5</sup>

Nishizawa reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate that one format of the data is used for an application executed on one database and the other format of the data (the data format that was converted to) is used for an application executed on another database. However Nishizawa teaches an application that is associated with one database (Col 10, Lines 4-5, i.e. *in the case that the application on the client computer is an associated database*). Given the intended broad application of the Nishizawa system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to convert data from one format to another for many reasons such as, compatibility and to allow for a

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<sup>4</sup> The Examiner would like to direct the Applicant's attention to the fact that ending the data conversion process (as in Figure 6, Element 608) is an indication that this process of sending and receiving this "request" is actually happening, also Figure 6, Element 607 is another good example for showing the transformation (conversion) at the current time.

<sup>5</sup> Please note the location of the data format transformation (conversion), i.e. "in the magnetic disk apparatus".

maximum use of a system when more than one format can be recognized. Further more converting data formats from one type to another is well known and whether the different formats are used in two different applications of two different databases or whether the different formats are used to convert data for two different devices such as, from voice to text or the opposite, no weight will be given to it as it is merely reciting the purpose and the intended use of the data conversion. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Nishizawa reference discloses all of the claimed subject matter set forth above, including the limitation of address of source data (Figure No. 9, Element No. 906, i.e. from employee), except the reference does not explicitly indicate the two limitations regarding the size of the data to be transformed and the destination address of the transformed data. However Suzuki discloses all of the three limitation, including the "address of source data", "the size of data to be transformed" and the "destination address" (Figure No. 2A, Element No. S2; see also Col 10, Lines 49-56, i.e. *a conversion source file name, a conversion destination file name, a board (PCB) size, and a flow direction are input (step S2). The operations for inputting the PCB size and the flow direction in this process are the operations with which the data of the data items such as the (6) flow direction and the (7) PCB size, which can be changed also immediately before the conversion process, are used unchanged, or the data are changed with an input if they are to be changed*). Given the intended broad application of the Nishizawa reference, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Nishizawa with the teachings of Suzuki in order to increase the flexibility of the system by presenting a

system that is more user friendly by allowing the user to directly specify the source, size and the destination of the transformed data, also to increase the process efficiency of the system.

Regarding Claim 7, Nishizawa discloses disk storage device connected to another host computer (Figure 2).

Regarding Claim 10, Nishizawa discloses the Internet as a protocol (Col 7, Lines 28-37).

Regarding Claim 17, Nishizawa discloses another data request and a third data format (Col 10, Lines 60-63)<sup>6</sup>.

8. Claims 9 and 12, is rejected under 35 U.S.C. 103(a) as being unpatentable over Itaru Nishizawa (U.S. Patent No. 6,519,598 and Nishizawa hereinafter) in view of Michael Brown (U.S. Patent No. 6,636,808 and Brown hereinafter).

Regarding Claim 9, Nishizawa's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the mainframe computer type. However Brown teaches a mainframe (Col 7, Lines 11-17). Given the intended broad application of the Nishizawa reference, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of

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<sup>6</sup> Please note that the indication of "designation of data format" (Col 10, Lines 60-61) is an indication that more than one format can be designated (third format). And if the system can transmit one request then why it can't transmit more than one?

Nishizawa with the teachings of Brown by specifying a mainframe computer for the host to hold larger amount of data than a regular computer or server.

Regarding Claim 12, Nishizawa's reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the TCP/IP protocol.

However Brown teaches TCP/IP (Col 5, Lines 26-35). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Nishizawa's reference to include a protocol such as the TCP/IP as it is a well know protocol to connect computers, just as the Internet Protocol (IP), Hypertext Transfer Protocol (HTTP) and others.

9. Claims 11 and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Itaru Nishizawa (U.S. Patent No. 6,519,598 and Nishizawa hereinafter) in view of Takashi Suzuki (U.S. Patent No. 6,125,304 and Suzuki hereinafter) and further in view Michael Brown (U.S. Patent No. 6,636,808 and Brown hereinafter).

Regarding Claims 11 and 13, the combination of Nishizawa's reference and Suzuki's reference discloses all of the claimed subject matter set forth above, except they do not explicitly indicate a SCSI protocol. However Brown teaches a SCSI protocol (Col 4, Lines 37-42). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of both Nishizawa's and Suzuki's references to include a SCSI protocol as it is a very common protocol to connect computers, just as the TCP/IP and/or the Internet, one other reason to use



SCSI protocol is due to it's known capabilities in transferring massive amount of data, such as large databases or mainframes with large amount of data.

### ***Response to Arguments***

10. Applicant's arguments filed in the amendment of June 1st, 2004 have been fully considered but they are not persuasive.

a- Applicant argues that Nishizawa's reference in combination with Suzuki's reference does not teach the limitations of the canceled Claim 2 (currently incorporated into Independent Claims 1, 3, 5, 14 and 16). The Examiner however disagrees. The combination of both Nishizawa and Suzuki does teach the limitations of "address of source data", "the size of data to be transformed" and the "destination address" (Figure No. 2A, Element No. S2; see also Col 10, Lines 49-56), i.e.

a conversion source file name, a conversion destination file name, a board (PCB) size, and a flow direction are input (step S2). The operations for inputting the PCB size and the flow direction in this process are the operations with which the data of the data items such as the (6) flow direction and the (7) PCB size, which can be changed also immediately before the conversion process, are used unchanged, or the data are changed with an input if they are to be changed.

***Points of Contact***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

if attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

*Haythim J. Alaubaidi*

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Patent Examiner  
Technology Center 2100  
June 28, 2004

  
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